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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,920	09/25/2003	Charles Dimitry Zayat		3870
7590	07/12/2005			
Maurice M. Lynch 479 Church Avenue Warwick, RI 02889			EXAMINER GATES, ERIC ANDREW	
			ART UNIT 3722	PAPER NUMBER

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/671,920

Applicant(s)

ZAYAT ET AL.

Examiner

Eric A. Gates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 1-4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 25 September 2003
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The reference to Zayat U.S. Patent #516,340, published 08-03-2002, is incorrect. This patent was issued to Weyer, published 03-13-1894. A corrected IDS should be submitted with the appropriate patent number, or with this reference removed.

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. In the instant application, the section titles do not appear in upper case and are written in bold type. Appropriate correction is required.

3. The abstract of the disclosure is objected to because the last sentence does not have an ending. It is not possible to distinguish if the sentence is missing a period or if the sentence was truncated. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:

- a. Under the section "Background and Objects of the Invention", the first sentence should be corrected to read: "There are many methods such as heat, chemicals, and various tool..." The paragraph referring to the Partington, Walsh, and Schultze patents should be corrected to read: "Schultz, #6,190,099" and "simultaneously grind two surfaces..."
- b. Under the section "Summary of the Invention", the last sentence should be corrected to read: "to improve its movement..."
- c. Under the section "Description of the Invention", the second paragraph should be corrected to read: "Figure 1 is an exploded..." In the fourth paragraph, "adjacent vertical surfaces" should be changed to "adjacent surfaces".

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d. Under the section "Detailed Description of the Drawings", the paragraph for Figure 3A should be corrected to read: "This ten-degree angle and a horizontal line 44..." In the paragraph for Figure 5, "device 2" is not labeled in the drawing. The last paragraph should be corrected to read: "parts may be made without departing..."

Appropriate correction is required.

### ***Claim Objections***

5. A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase "means for " or "step for ";

(B) the "means for " or "step for " must be modified by functional language;

and

(C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function.

In claim 2, paragraphs b, c, and d, 35 U.S.C. 112, sixth paragraph is not invoked properly, as the phrase "means for" is not used. If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines; or (B) show that even though the phrase "means for" or "step for" is not used, the claim limitation is written as a function to be performed and does not recite

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sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112, sixth paragraph.

6. Claim 1 is objected to because of the following informalities: The phrase "We claim" should not be repeated at the beginning of the sentence. The phrase "said tool consists of three major components" should be amended to "said tool comprises three major components". Appropriate correction is required.

7. Claim 4 is objected to because of the following informalities: The word "there" should be replaced with "they". Appropriate correction is required.

8. Claims 1, 3, and 4 are objected to because of the following informalities: These claims do not end with a period. Appropriate action is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 2-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in

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the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a. Claim 2b includes the limitations "cutting, grinding or sanding edges". There is a lack of antecedent basis for the claim, as there is no previous mention of using the invention as a grinder or sander.
- b. Claim 3 describes "two replaceable cutting blades at a 1-20 degree angle off the perpendicular." There is no written support for determining how this angle is measured off the perpendicular in the specification.
- c. Claims 3 and 4 include descriptions giving the orientation of the blades on the bar style holder. This information is not discussed in the specification.

The specification should be revised to clearly include the subject matter in the claims not previously communicated.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- c. Claim 1 refers to a "rigid guard housing/dust collector". It is not possible to determine if the claim is referring to a rigid guard housing and a dust collector, a

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rigid guard housing or a dust collector, or a rigid guard housing and/or a dust collector. Claim 2 similarly refers to a "rigid guard/dust collecting device".

d. Claim 3 describes "two replaceable cutting blades at a 1-20 degree angle off the perpendicular." Since the specification does not give any details concerning the angle at which the cutting blades should be set, it is not possible to determine if the claim is referring to a range of 1 to 20 degrees, or is attempting to claim some other value, such as 120 degrees, or from where this measurement should be taken.

The specification should be revised to distinctly include the subject matter in the claims not previously communicated.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (U.S. Patent 6,190,099) in view of Reppert (U.S. Patent 3,875,838). Schultz discloses a rotary tool with a flat oriented bottom-cutting surface and three adjacent perpendicular cutting surfaces. Schultz further discloses a protective cover 62 with a dust collection conduit 68, which may be attached to a dust collection device, not shown. Protective cover 62 leaves lateral opening 48 uncovered to allow for simultaneous treatment of the



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adjacent perpendicular surface. The depth of cutting to the horizontal surface is controlled by means of compensating disks 22 or a spring means 70. Schultz also discloses the use of two replaceable cutters 30 attached to a face milling cutter 16, which is attached to the motor tool spindle 6. Schultz does not disclose the use of a rotating bar style holder or a means for controlling the depth of cutting to the vertical surface. Reppert teaches the use of knife bar holders 50 for holding the cutting blades 52 for the purpose of reducing the weight of the invention. Therefore it would have been obvious to one having ordinary skill in the art to have used a bar holder with the rotary tool of Schultz in order to reduce the total weight of the tool.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz in view of Reppert as applied to claim 1 above, and further in view of Zayat (U.S. Patent 4,554,957). The modified tool of Schultz and Reppert discloses the invention substantially as claimed except for an adjustment means to control the depth of the cutting device to the vertical surface being treated. Zayat teaches the use of a guide means 52 for the purpose of controlling the depth of the cut to butt edge 20. Therefore it would have been obvious to one having ordinary skill in the art to have used the guide means of Zayat with the rotary tool of Schultz in order to remove more or less material from the vertical work surface.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz in view of Reppert as applied to claim 1 above, and further in view of Dehde (U.S. Patent 6,148,880) and Waite (U.S. Patent 4,483,228). The modified tool of Schultz and Reppert discloses the invention substantially as claimed except for the blade angle and

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orientation. Dehde teaches using a blade angle  $\lambda Hn$  in the range of 0 to 20° perpendicular to the plane of rotation of the blade holder where the top of the blade is away from the direction of rotation and the point of the blade that meets the horizontal surface faces toward the direction of rotation for the purpose of creating larger shavings. Waite teaches orienting the flat surface of the blade parallel to the rotary axis of the wheel, i.e. parallel to the cut surface for the purpose of removing material from the cut surface in a manner that leaves the cut surface essentially flat. Therefore it would have been obvious to one having ordinary skill in the art to have used the blade angle and blade orientation of Dehde and the blade orientation of Waite with the rotary tool of Schultz in order to remove larger shavings from the cut surface while leaving the cut surface flat.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz in view of Reppert, Dehde, and Waite as applied to claim 3 above, and further in view of Helm (U.S. Patent 3,977,283). The modified tool of Schultz, Reppert, Dehde, and Waite discloses the invention substantially as claimed except for the planar parallelogram shape of the blades. Helm teaches the use of knife blades 46 with a parallelogram configuration for the purpose of cutting the material to the desired shape. Therefore it would have been obvious to one having ordinary skill in the art to have used the parallelogram configuration of Helm with the rotary tool of Schultz in order to retain the perpendicularity of the horizontal and butt end surfaces in the material to be cut.

**Conclusion**

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 5,727,913 to Naim discloses a double edge trimming tool.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates, whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:00-4:30 & alt Fridays 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley, can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
EAG

Eric A. Gates  
Patent Examiner  
Art Unit 3722

  
BOYER D. ASHLEY  
PRIMARY EXAMINER